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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/856,835	02/26/2002	Ralf Otto	H 4148 PCT/US	4730

23657 7590 06/17/2003

COGNIS CORPORATION  
2500 RENAISSANCE BLVD., SUITE 200  
GULPH MILLS, PA 19406

EXAMINER

HENRY, MICHAEL C

ART UNIT	PAPER NUMBER
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1623

DATE MAILED: 06/17/2003

11

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Applicati n N .

09/856,835

Applicant(s)

OTTO ET AL.

Examiner

Michael C. Henry

Art Unit

1623

-- The MAILING DATE of this c mmunication appears on the c v r sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 4/13/03
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 24-35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 24-35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Pri rity under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_ .
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ .
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_ .
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_ .

### DETAILED ACTION

The following office action is a responsive to the Amendment filed, 09/23/02.

The amendment filed 04/13/03 affects the application, 09/856,835 as follows:

1. Claims 12-23 have been cancelled. Claims 24-35 have been added. This leaves claims 24-35.
2. Applicant responds to the 112 2<sup>nd</sup> rejections by canceling claims 12-23, rendering said rejection moot.

The responsive to applicants' arguments is contained herein below.

#### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 24-30, 33 and 35 are rejected under 35 U.S.C. 102(b) as being anticipated by Pearl et al. (Phytochemistry, 1992, 31(8), 2909-10).

In claim 24, applicants claim "a salicyl alcohol derivative of the formula (I):  $R^1-OCH_2-Ph-O-Z-(R^2)_n$  .....". Pearl et al. disclose applicants' salicyl alcohol derivative of claim 24, wherein the substituent  $R^2$  is a benzoyl,  $R^1$  is H, and Z is glucose. This compound is named, .beta.-D-Glucopyranoside, 2-(hydroxymethyl)phenyl, 2-benzoate (and is also named tremuloidin (cas # 529-66-8) (see abstract and compound 5, page 2910)). In claim 25, applicants claim "a salicyl alcohol derivative of claim 24, wherein at least one of the two substituents  $R^1$  and  $R^2$  is a hydrogen atom, or a benzoyl....." Pearl et al. disclose applicants' salicyl alcohol derivative

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of claim 25, wherein the substituent  $R^2$  is a benzoyl,  $R^1$  is H, and Z is glucose. This compound is named, .beta.-D-Glucopyranoside, 2-(hydroxymethyl)phenyl, 2-benzoate (and is also named tremuloidin (cas # 529-66-8) (see abstract and compound 5, page 2910)). It should be noted that claims 26-30, 33,35 are also encompassed by this rejection. Claims 31-35 are rejected to as being dependent on a rejected claim.

***Allowable Subject Matter***

The following is an examiner's statement of reasons for allowance: The examiner has found claims 31, 32 and 34 to be unobvious over the prior art of record and therefore to be allowable over the prior art of record, only if rewritten in independent acceptable form and/or excluding any dependency on a rejected claim and, with the exclusion of new issues or matter.

The Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael C. Henry whose telephone number is 703 308-7307. The examiner can normally be reached on 8:30 am to 5:00 pm; Mon-Fri. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James O. Wilson can be reached on 703 308-4624. The fax phone number for the organization where this application or proceeding is assigned is 703 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308-1235.

MCH

June 13, 2003.

  
SAMUEL BARTS  
PRIMARY EXAMINER  
GROUP 1200